

REMARKS

In the Office Action dated 6 August 1998, the Examiner rejected claims 1-34 under 35 U.S.C. § 102(e) as being anticipated by Clark, II et al. In that Office Action, the Examiner states that “Clark, II et al. teach a method ... comprising receiving data blocks, compressing the data blocks, evaluating the resulting compression, and ceasing application of that compression process if the compression fails to satisfy predetermined compression criteria.”

Applicant respectfully disagrees. Applicant submits that Clark, II et al. appears not to disclose nor suggest utilizing “multiple input data blocks” as recited in independent claims 1, 12, 23, and 34. For example, claim 1 recites “applying a predetermined compression process to the data blocks” and “evaluating application of the predetermined compression process.” The Examiner references FIG. 2 and cols. 3-4 of Clark, II et al., which appears to describe a compression of a single data block (step 38) or a compression of a larger data block (repeating steps 36-39). Therefore, the Examiner’s rejection of claims 1-34 under 35 U.S.C. § 102(e) is improper and should be withdrawn.

If the Examiner is relying on inherency in Clark, II et al., the Applicant submits that the Examiner must provide rationale or evidence tending to show inherency. "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." Ex parte Levy, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (where the Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of inherency). "The fact the a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Since no inherency evidence is shown, the Examiner's rejection of claims 134 under 35 U.S.C. Sec. 102(e) is further improper and should be withdrawn.

Claims 2, 13, and 24 recite further limitations not addressed by the Examiner. For example, claim 2 recites "if the number of data blocks having a compression ratio greater than the first threshold exceeds a second threshold, the compression satisfying the predetermined compression criteria." Clark, II et al. describes calculating a single compression coefficient (e.g., col. 4, lines: "After a compression coefficient is calculated"). Since the Examiner has not addressed such additional limitations, the

Examiner's rejection of claims 2, 13, and 24 under 35 U.S.C. § 102(e) is further improper and should be withdrawn.

Claims 9, 20, and 31 recite further limitations not addressed by the Examiner. For example, claim 9 recites "predetermined skip criteria comprising expiration of predetermined time." Since the Examiner has not addressed such additional limitations, the Examiner's rejection of claims 9, 20, and 31 under 35 U.S.C. § 102(e) is further improper and should be withdrawn.

Claims 11, 22, and 33 recite further limitations not addressed by the Examiner. For example, claim 11 recites "predetermined skip criteria comprising storage of a predetermined number of data items without compression according to the predetermined compression process." Since the Examiner has not addressed such additional limitations, the Examiner's rejection of claims 11, 22, and 33 is further improper and should be withdrawn.

Applicant respectfully requests reconsideration of claims 1-34 in light of the arguments herein.

Applicant believes there are no fees required for this Response, however, authorization is given to debit USPTO Deposit Account No. 09-0442 for any fee that may be due.

Should the Examiner have any questions regarding this Response, he is respectfully requested to contact the undersigned.

Respectfully submitted,



Date: September 1998

TERRANCE A. MEADOR
Attorney for Applicant
Reg. No. 30, 298

GRAY CARY WARE & FREIDENRICH
401 B Street, Suite 1700
San Diego, California 92101

Telephone: (619) 699-2652 Fax: (619) 236-1048